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**REMARKS**

Applicants appreciate the Examiner's thorough examination of the subject application and request reconsideration of the subject application based on the foregoing amendments and the following remarks.

Claims 1-18 are pending in the subject application.

Claims 1-18 stand rejected under 35 U.S.C. §103.

Claims 1, 7, 15, 17 and 18 were amended to more distinctly claim Applicants' invention. More particularly, the method claims were amended to clarify that the recording method is that for magnetic recording medium where the recorded information recorded therein is read out magnetically to clearly distinguish any recording methods used in conjunction with magneto-optical recording mediums. Also, the claims were amended to further clarify how the recordable region, more particularly the edge of the recordable region is located on the magnetic recording medium. In this regard, Applicants would note that a recordable region is passively defined by the magnetic field distribution, the temperature distribution and the temperature dependency of the coercive force of the magnetic recording medium. The amendments to the claims are supported by the originally filed disclosure (e.g., see page 36, line 14 to page 37, line 2).

**35 U.S.C. §103 REJECTIONS**

Claims 1-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over the cited prior art for the reasons provided on pages 2-7 of the above-referenced Office Action. Because claims were amended in the foregoing amendment, the following discussion refers to the

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language of the amended claim(s). However, only those amended features specifically relied on in the following discussion shall be considered as being made to overcome the prior art reference. The following addresses the specific rejections provided in the above-referenced Office Action.

In the Office Action it is asserted that the term greatest rate is not well defined in the subject application and indicates that reference is made to a number of pages of text found in the Summary of Invention section of the subject application. In this regard, Applicants would suggest that the Examiner review for example the discussion contained on pages 35-41 of the subject application as well as Figs. 3, 4 and 6(a)-(c). In particular reference should be more particularly made to page 36, line 14 to page 37, line 2, page 54, lines 12-24 and page 69; line 19 to page 70. It would appear that the Office Action only referred to excerpts from the Summary of Invention portion of the subject application, whereas the above noted excerpts by Applicants are from the Description of the Embodiments portion of the subject application.

Also and in the interests of advancing prosecution, Applicants would note that for clarity the independent claims were each amended so as to use the term maximum instead of greatest/largest rate. In addition, the specification also was amended so as to also refer to the term maximum as well for consistency of terminology. It is respectfully submitted that the description and technical content in the originally filed disclosure comprising the subject application supports the foregoing amendment to the claims as well as to the subject application and thus does not constitute new matter. As such, entry of the amendments to the claims and the specification is respectfully requested.

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**CLAIMS 1, 2, 6, 7, 10, 14, 15, 17 & 18**

Claims 1, 2, 6, 7, 10, 14, 15, 17 and 18 stand rejected as being unpatentable over Onagi (USPN 5,757,736) in view of Nakayama et al. (USPN 5,666,332; "Nakayama") for the reasons provided on pages 2-4 of the above referenced Office Action. Applicants respectfully traverse.

As grounds for the rejection, the above-referenced Office Action provides that Onagi teaches the method of magnetic signal recording of claims 1, 7, 15 and 17 except that Onagi does not teach that the magnetic field intensity in an in-track position in which a magnetic field distribution generated by the magnetic recording head is lowered at a greatest rate. It is further asserted that Nakayama provides the missing teachings and that it would have been obvious to one skilled in the art to modify the intensity of the light to control the rate in order to control the intensity of the recording laser. As to claim 18, it is asserted that this claim is drawn to an apparatus corresponding to the method of using the method of claims 1, 7, 15 and 17 and thus is rejected for the same reasons as for claims 1, 7, 15 and 17.

**CLAIM 18**

Applicants claim, a magnetic recording-reproduction apparatus that includes magnetic signal recording means for recording a magnetic signal in accordance with a magnetic signal recording method, and magnetic signal reproduction means for reproducing a magnetic signal recorded in a magnetic recording medium by said magnetic signal recording means. It is further indicated that said magnetic signal recording method includes the step of recording arbitrary

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information in a region on said magnetic recording medium where a coercive force has been varied with local heating, in accordance with a magnetic field from a magnetic recording head. With such recording a positional relationship between a magnetic field distribution and the distribution of a coercive force of the magnetic recording medium is determined in such a manner as to generate an edge of a recordable region at a position where a recording magnetic field intensity is lowered at a maximum. In this regard, Applicants would note that a recordable region is passively defined by the magnetic field distribution, the temperature distribution and the temperature dependency of the coercive force of the magnetic recording medium.

The foregoing rejection is based on the incorrect premise that the basic device set forth in claim 18 for recording and reproducing information is that disclosed and taught in the cited combination of references. As had been previously indicated by Applicants in the Response dated June 9, 2004 (e.g., see pages 9 and 10 thereto); the mediums being disclosed and taught in both Onagi and Nakayama are magneto-optical recording mediums. As herein discussed, magneto-optical recording mediums are different in structure and the information recorded therein is read out using different techniques and devices/apparatuses than the techniques/devices for magnetic mediums in which the information is read out magnetically.

As also previously indicated by Applicants, the invention disclosed and described in Onagi relates to an information recording method and apparatus for "recording information by using light intensity modulation recording method or magnetic modulation recording method." The object of the information recording method and apparatus of Onagi is to be able to form a

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recorded mark with a stable and small size even if an intensity of a light beam is varied (e.g., see col. 2, lines 24 to 27, or the like).

As is well known to those skilled in the magneto-optical medium arts (see also pages 10-15 of Applicants' Response dated June 6, 2004), one does not magnetically read out the information recorded in a magneto-optical recording medium such as that disclosed in Onagi as that terminology is intended to mean in the subject application. Rather for magneto-optical recording mediums, one detects the direction of vertical magnetization that is recorded in the magneto-optical recording medium. As is known to those skilled in the magneto-optical recording medium arts, and as more particularly described in the discussion concerning the secondary reference, the direction of the vertical magnetization is detected from the rotation of the polarization plane of the light being reflected from the surface of the reproducing layer 4 thereby allowing one to determine if the direction of vertical magnetization is downward (generally corresponding to a digital or binary "0") or if the direction of vertical magnetization is upward (generally corresponding to a digital or binary "1"). This technique does not correspond at all to a technique where information is read out of a medium using magnetic reading techniques.

Consequently, it is completely impossible for either Onagi or Nakayama to teach the "magnetic signal reproduction means for reproducing a magnetic signal recorded in a magnetic recording medium by said magnetic signal recording means" as set forth in claim 18. It is clear from the discussion in the subject application that the magnetic signal reproduction means of the present invention does not correspond to a mechanism that detects the rotation of the polarization

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plane of the light being reflected from the surface of the reproducing layer so as to determine the direction of vertical magnetization. Furthermore, the two cited references *could not be modified* to include the magnetic signal reproduction means of the present invention, because such a modification would render the apparatuses disclosed in Onagi and Nakayama completely inoperable.

Thus, the fact that the magnetic signal recording means records a magnetic signal in accordance with a magnetic signal recording method that might correspond to one of the claimed methods does not mean that the structure of the claimed apparatus can be ignored or that patentability of the apparatus shall be determined solely based on the limitation setting forth the method.

The inventions described in both Onagi and Nakayama do *not* reproduce the magnetic signal that is recorded in the magneto-optical recording medium. Rather Onagi and Nakayama both teach and describe the well known technique of detecting the rotation of the polarization plane of the light being reflected by the medium and using this to determine a direction of magnetization. Thus, Onagi and Nakayama (alone or in combination) do not describe, teach nor suggest the magnetic signal reproduction means (*e.g.*, a reproduction head 41) that is described in the subject application and set forth in claim 18.

In addition, and with reference to the following discussion regarding the methodology of the present invention, it also is respectfully submitted that the apparatus of claim 18 also is distinguishable because of its embodiment of the present invention's methodology.

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Applicants thus respectfully submit that claim 18 is distinguishable from the cited combination of references and thus is considered to be allowable.

CLAIMS 1, 2, 6, 7, 10, 14, 15, & 17

Applicants claim, claim 1, a magnetic signal recording method in which information is recorded to a magnetic recording medium and read magnetically from the recording medium. Such a magnetic signal recording medium includes recording arbitrary information in a region on a magnetic recording medium where a coercive force has been varied with local heating, in accordance with a magnetic field from a magnetic recording head. Such recording of the arbitrary information is carried out under such conditions such that a positional relationship between a magnetic field distribution and the distribution of a coercive force of the magnetic recording medium is determined/ established in such a manner as to generate an edge of a recordable region at a position where a recording magnetic field intensity is lowered at a maximum. In this regard, Applicants would note that a recordable region is passively defined by the magnetic field distribution, the temperature distribution and the temperature dependency of the coercive force of the magnetic recording medium.

As indicated herein, Applicants amended claim 1 so as to indicate that the method applies to recording information in a recording medium in which the recorded information is being readout magnetically. As indicated above in the discussion regarding claim 18, the teachings and disclosures of the cited combination of references are limited to the magneto-optical arts. Thus, both references clearly do not apply or relate to techniques/ methods wherein information

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recorded in the magnetic medium is read out magnetically. As such, at least for this reason claim 1 is considered to be allowable.

As also indicated herein, and in the interests of advancing prosecution, claim 1 was further amended to provide that a positional relationship between a magnetic field distribution and the distribution of a coercive force of the magnetic recording medium is determined/ established in such a manner as to generate an edge of a recordable region at a position where a recording magnetic field intensity is lowered at a maximum. As further discussed hereinafter, it is submitted claim 1 is further considered to be in allowable form at least because of the addition of this language.

As is explained in the subject application, the shape of the magnetic bit in heat-assisting magnetic recording methods is dependent upon the temperature distribution and the magnetic field distribution (e.g., see pg. 3 of the subject application). It also is stated therein that Applicants discovered that, at least with regards to a referenced PCT application, the magnetic field distribution of the magnetic head was not being taken into consideration, which would preclude recording a magnetic bit having a rectangular shape. It is further stated in the subject application, that the shape of the magnetic bit being recorded in the magnetic medium is determined by a change in the magnetic characteristics of the magnetic recording medium due to temperature, the temperature distribution formed on the magnetic recording medium and the magnetic field being applied onto the magnetic recording medium (e.g., see pg. 6 of the subject application).

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The magnetic signal recording method(s) of the present invention are such as to perform magnetic recording while heating up a recording medium. According to the magnetic signal recording method(s) of the present invention is provide "in which a magnetic bit having a shape that is most suitable for reproduction is formed in a substantially constant shape in a view of a magnetic field distribution of a magnetic recording head, so as to significantly improve an S/N of a reproduction signal".

As indicated herein and as claimed by Applicants, to achieve the foregoing, the magnetic signal recording method according to the present invention, adopts the arrangement and is carried out under such conditions that a positional relationship between a magnetic field distribution and the distribution of a coercive force of the magnetic recording medium is determined/ established in such a manner as to generate an edge of a recordable region at a position where a recording magnetic field intensity is lowered at a maximum.

In sum, a feature characterizing the present invention is that a positional relationship between a magnetic field distribution and the distribution of a coercive force of the magnetic recording medium is determined/ established in such a manner as to generate an edge of a recordable region at a position where a recording magnetic field intensity is lowered at a maximum. In this way, the edge of the recordable region can be caused to have a shape more approximate to the shape of contour lines of the recording magnetic field distribution. Therefore, by using the magnetic recording head by which the recording magnetic field is distributed in a rectangular shape it is possible to attain rectangular-shaped counter lines of the recording magnetic distribution. As a result, the shape of the edge of the recordable region becomes

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rectangular and thus, it is possible to record the recording bit in the rectangular shape. This yields a magnetic signal recording method and a magnetic signal recording-reproduction apparatus with which the signal to noise (SN) ratio of the reproduction signal of the magnetic recording medium can be significantly improved.

As discussed below, a review of the primary and secondary references (*i.e.*, Onagi and Nakayama respectively) reveals that there is no discussion found in either of these references that refers to or describes an inability to control the shape of the magnetic bit being formed from recording. More particularly, the references alone or in combination nowhere describe that recording is carried out under such conditions that a positional relationship between a magnetic field distribution and the distribution of a coercive force of the magnetic recording medium is determined/ established in such a manner as to generate an edge of a recordable region at a position where a recording magnetic field intensity is lowered at a maximum. This is not surprising as the specific mediums disclosed and in the primary and secondary references are magneto-optical recording mediums that are used in different methodologies than that of the present invention.

The invention disclosed and described in Onagi relates to an information recording method and apparatus for "recording information by using light intensity modulation recording method or magnetic modulation recording method." The object of the information recording method and apparatus of Onagi is to be able to form a recorded mark with a stable and small size even if an intensity of a light beam is varied (see col. 2, lines 24 to 27, or the like).

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Onagi also explains, discloses and describes about the size of the recording mark, however, Onagi has no consideration on the shape of the recording mark or taking steps to control the recording/ readout process. Further, it appears that the recording mark formed by the information recording method and apparatus disclosed and taught in Onagi has a "circular" shape as clearly indicated by record mark "M" in Figures 5 and 8A, and the like. That is, the information recording method and the apparatus of Onagi deal with and are configured for the *circular recording mark*. It should be noted that the circular shape is a generally used shape.

Further, the specification and drawings of Onagi do not discuss a shape other than the circular shape. It necessarily follows from the foregoing therefore, that Onagi cannot disclose, describe, teach nor suggest the above-described feature(s) characterizing the present invention, namely that the edge of the recordable region is located in a position in which the magnetic field intensity is lowered at the greatest rate.

Also and in contrast to the present invention, the magneto-optical medium described in Onagi includes a plurality or more of individual magnetic layers; namely a reproducing layer 4, an intermediate layer 5, a first recording layer 6 and a second recording layer 7 (see col. 10, lines 53-67). It is clear from the discussion in Onagi that the first and second recording layers contribute to the recording operation of the magneto-optical recording medium and that the reproducing layer 4, the intermediate layer 5 and the first and second recording layers contribute to the reproducing and recording operations of the medium (sec col. 11, lines 13-22). It also is clear from the discussion in Onagi that the intermediate layer 5 functions as switching or masking layer.

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Onagi describes a number of different recording operations that are performed at different times or conditions. In this regard it should be noted that information is recorded in the recording medium in Onagi by means of controlling the direction of the vertical magnetization of the first and second recording layers 6,7. As is known to those skilled in the magneto-optical recording arts and as more particularly described in the discussion concerning the secondary reference, the direction of the vertical magnetization is detected from the rotation of the polarization plane of the light being reflected from the surface of the reproducing layer 4 thereby allowing one to determine if the direction of vertical magnetization is downward (generally corresponding to a digital or binary "0") or if the direction of vertical magnetization is upward (generally corresponding to a digital or binary "1").

The first step that is generally undertaken as part of recording operations for a typical rewritable magneto-optical recording medium such as that disclosed in Onagi is performed prior to the recording of any specific information. As described in Onagi, in this initializing step, the magneto-optical recording medium is heated and subjected to a biasing magnetic field so that all the directions of magnetization in both the first and second magnetic layers 6,7 are aligned so as to be in the same direction (*i.e.*, all downward direction) such as that illustrated in figure 4A of Onagi.

When recording specific information, namely to change the direction of vertical magnetization of the first and second recording layers 6,7, Onagi indicates/ teaches that the light beam heats the medium so that the second recording layer 7 is at a temperature higher than the Curie temperature of the second layer and so the first recording layer is heated to a temperature

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lower than the Curie temperature of the first layer. More specifically, the temperature the medium is being heated to a temperature in the range A as shown in figure 2 of Onagi. It is further described in Onagi (e.g., see cols. 17-18) that an external magnetic field set to a constant magnitude is applied to the record position by the magnetic head 15 as shown in figure 4C. When the medium is heated so as to be in the state shown in figure 4B, the magnetic coercive force of the first recording layer in a central portion of the light beam becomes weaker than the magnitude of the external magnetic field thus allowing the direction of magnetization of the central portion to be changed to correspond to the direction of the external magnetic field.

After the recording mark is formed in the first recording layer, the heating by the light beam is stopped (e.g., by rotation of the magneto-optical disc) and as such the temperature of this recording position is reduced. Thereafter, and as illustrated in figure 4D therof the direction of magnetization of the first recording layer 6 is copied to the second recording layer 7. As further described in Onagi, as the magneto-optical medium is cooled further the coercive force of the second recording layer 7 increases and becomes stronger than that of the first recording layer 6. More specifically, Onagi teaches that at room temperature the coercive force of the second recording layer 7 is stronger than the coercive force of the first recording layer 6 at room temperature.

As to the secondary reference, Nakayama describes magneto-optical recording mediums that include a plurality or more of individual magnetic layers that are each constituted so that the individual layers can have specific functions (e.g., switching, masking) and/ or have different properties or characteristics dependent upon temperature. As described in col. 2, lines 47-65

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thereof, for example, when laser light of a high power is applied the temperature of a portion of the magneto-optical recording medium is raised to T3 which is in the vicinity of the Curie temperature of the third magnetic layer 24 and when laser light of a low power is applied to a portion of the magneto-optical recording medium the temperature is raised to T2 which is in the vicinity of the Curie temperature of the first magnetic layer 22. Thus, when heated to a high power and while a recording magnetic field (Hw) is being applied; the direction of magnetization of the third magnetic layer 24 is reversed upward. It is further described that in the process of the medium cooling off following heating to a high power, the direction of magnetization in the third magnetic layer is successively copied to the second and first magnetic layers.

During reproduction, the power of the laser beam is set considerably lower than the power used during a recording operation. As further described and taught in Nakayama, when the reproducing light beam is applied, the in-plane magnetization state of the second or intermediate magnetic layer 23 is unaffected by the such laser light beam and thus the second magnetic layer 23 prevents the direction of magnetization of the third layer from being copied to the first layer by means of the exchange-coupling force. See col. 3, lines 12-20 of Nakayama.

As also indicated in Nakayama (see col. 9, lines 45-53) and as known to those skilled in the magneto-optical arts, the reproducing operation is carried out to detect the rotation of the polarization plane of the reflected light of the applied laser beam 9. As is known to those skilled in the magneto-optical recording art(s), this can be utilized to determine the direction of magnetization of the first magnetic layer.

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Nakayama also clearly teaches that such a magneto-optical medium is subjected to an initializing magnetic field ( $H_i$ ) that is greater than the coercive force of the third magnetic layer at room temperature so the direction of magnetization in only the third layer is in one direction. See col. 2, lines 26-32 and col. 3, lines 21-34 of Nakayama.

Moreover, the optical-magneto recording medium and the recording method of Nakayama has as an object allowing an initializing magnetic field to be set smaller than recording magnetic field, thereby reducing the size of a recording device (See col. 3, lines 54 to 60). Also, while Nakayama explains/ discloses the material and the characteristics of the magnetic layer (e.g., recording layer) of the optical-magneto recording medium, Nakayama has no consideration on the shape of the recording bit. Therefore, Nakayama does not disclose, teach nor suggest any technical content that one skilled in the art would conclude corresponds to characteristics of the present invention including that the edge of the recordable region is located in a position in which the magnetic field intensity is lowered at the greatest rate.

The Office Action refers to the discussion in col. 2, lines 39-46 of Nakayama as support for the assertion that Nakayama teaches a medium in which light intensity is controlled between a high and low power to control the magnetization. This discussion in Nakayama describes how the heating of the magneto-optical medium can be used to control the magnetization of the individual magnetic layers that make up the magneto-optical recording of Nakayama for recording and/ or reproduction. This does not describe, teach nor suggest in anyway, however, the particular characteristics or properties of the external magnetic field being generated by the magnetic head and being applied to the magneto-optical recording medium. More specifically, in

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Onagi the external magnetic field being applied is characterized as being constant and the discussion in Nakayama indicates that the external magnetic field has a fixed value.

There also is no discussion anywhere in Onagi that recording is carried out under such conditions such that a positional relationship between a magnetic field distribution and the distribution of a coercive force of the magnetic recording medium is determined/ established in such a manner as to generate an edge of a recordable region at a position where a recording magnetic field intensity is lowered at a maximum. In this regard, it is clear that the edge of the recordable region in Onagi and Nakayama is being defined or established by the heating characteristics of the light beam that is being applied to the medium. In other words, in Onagi if a portion of the medium is at or above a certain temperature the externally applied magnetic field can cause the direction of magnetization to change in this portion and in other areas that are at a temperature that is below the certain value the externally applied magnetic field cannot effect a change to the direction of magnetization of the magneto-optical recording medium.

Applicant also would note that Onagi and Nakayama do not anywhere describe the problem identified in the subject application, do not anywhere describe the solution to this problem and do not include figures, for example like figures 1-8 of the subject application, that are used to describe the method and apparatuses of the present invention. This is not surprising as the present invention is directed to methods and apparatuses for recording magnetic signals of arbitrary information in a magnetic recording medium whereas the apparatuses and techniques disclosed and taught in Onagi and Nakayama are directed to the recording of directions of magnetization in a magneto-optical recording medium. While both inventions do involve the use

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of magnetism, the techniques and mediums are different from each other. Thus, it cannot be said that techniques for recording information in a magneto-optical recording medium necessarily apply to the recording of magnetic signals in a magnetic recording medium.

Applicants also would remind the Examiner, that there is no drawing figure in either Onagi or Nakayama that illustrates the magnetic field distribution of the magnetic field being generated by the magnetic recording head of either of Onagi or Nakayama. Further, there is no discussion found anywhere in either Onagi or Nakayama that in effect describes how the magnetic field distribution of the magnetic field being generated by the magnetic recording head is established or varies as a function of the in-track position. In sum, it can hardly be said that Onagi or Nakayama describe, teach or suggest carrying out recording under such conditions that a positional relationship between a magnetic field distribution and the distribution of a coercive force of the magnetic recording medium is determined/ established in such a manner as to generate an edge of a recordable region at a position where a recording magnetic field intensity is lowered at a maximum. This should not be surprising as both Onagi and Nakayama are directed to particular make-ups or constitutions of magneto-optical recording mediums so that these mediums exhibit certain operational characteristics when they are heated for recording and/ or reproduction.

It also is submitted that reference is being made to the mediums and related methods of magneto-optical recording mediums as taught in Onagi and Nakayama. Such magneto-optical recording mediums and related methods are necessarily inconsistent with the magnetic signal recording method of the present invention as herein described/ discussed.

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Each of claims 2 and 6 depend from claim 1. As such, Applicant submits that claims 2 and 6 are considered to be allowable at least because of their dependency from a base claim that is considered to be allowable.

Applicant submits that the forgoing remarks distinguishing the magnetic signal recording method of claim 1 from the cited combination of Onagi and Nakayama also apply to distinguish the magnetic signal recording method as set forth in claims 7, 10 and 14, the magnetic signal recording method as set forth in claim 15, and the magnetic signal recording method of claim 17.

It is respectfully submitted that claims 1, 2, 6, 7, 10, 14, 15 and 17 are patentable over the cited reference(s) for the foregoing reasons.

#### **CLAIMS 4, 5, 12 & 13**

Claims 4, 5, 12 and 13 stand rejected as being unpatentable over Onagi (USPN 5,757,736) in view of Nakayama et al. (USPN 5,666,332; "Nakayama") as applied to claims 1 and 7, respectively, and further in view of Greidanus et al. (USPN 5,371,721; Greidanus") for the reasons provided on pages 4-5 of the above referenced Office Action. Applicants respectfully traverse.

Each of claims 4, 5, 12 and 13 depend from claims 1 and 7 respectively. As indicated above, each of claims 1 and 7 are considered to be patentable over the combination of Onagi and Nakayama. Thus, and at least because of their dependency from a base claim that is considered to be allowable, each of claims 4, 5, 12 and 13 are considered to be allowable.

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As to the tertiary reference, Greidnaus, this reference is being cited as basis for the features/ limitations set forth in claims 4, 5, 12 and 13. As such, Greidanus does not overcome the shortcomings identified above for each of claims 1 and 7. Applicant also would note that Greidanus like Onagi and Nakayama is directed to a magneto-optical recording medium. Thus Greidanus also does not disclose, teach or suggest methods for recording magnetic signals in a magnetic recording medium as those terms are used in the subject application. More particularly, Greidanus does not anywhere describe, disclose, teach, suggest nor provide the technical content that one skilled in the art would assert corresponded to characteristics of the present invention, more specifically that the edge of the recordable region is located in a position in which the magnetic field intensity is lowered at the greatest rate.

It is respectfully submitted that claims 4, 5, 12 and 13 are patentable over the cited reference(s) for the foregoing reasons.

#### CLAIM 8

Claim 8 stands rejected as being unpatentable over Onagi (USPN 5,757,736) in view of Nakayama et al. (USPN 5,666,332) as applied to claim 7 and in further view of Miyata et al. (USPN 6,611,388; "Miyata") for the reasons provided on page 5 of the above referenced Office Action. Applicants respectfully traverse.

Claim 8 depends from claim 7. As indicated above, claim 7 is considered to be patentable over the combination of Onagi and Nakayama. Thus, and at least because of its

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dependency from a base claim that is considered to be allowable, claim 8 is considered to be allowable.

As to the tertiary reference, Miyata, this reference is being cited as basis for the features/ limitations set forth in claim 8. As such, Miyata does not overcome the shortcomings identified above for claim 7. Also, Miyata does not anywhere describe, disclose, teach, suggest nor provide the technical content that one skilled in the art would assert corresponded to characteristics of the present invention, more specifically that the edge of the recordable region is located in a position in which the magnetic field intensity is lowered at the greatest rate.

The Office Action also asserts that it would have been obvious to one skilled in the art to modify the invention of Onagi and Nakayama based on the teachings of Miyata. It should be recognized that the invention in Miyata is directed to magnetic recording-reproducing apparatuses in which magnetic signals are recorded in a magnetic recording medium sometimes referred to as a magnetic hard disk. The Office Action, however, does not provide any basis on which one skilled in the art of magneto-optical recording mediums would adopt techniques, compositions or structures associated with magnetic hard disks so as to yield a method for recording magnetic signals in a magnetic recording medium.

It is respectfully submitted that claim 8 is patentable over the cited reference(s) for the foregoing reasons.

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### **CLAIMS 9, 16**

Claim 9 and 16 stand rejected as being unpatentable over Onagi (USPN 5,757,736) in view of Nakayama et al. (USPN 5,666,332) as applied to claims 7 and 15, respectively, and further in view of Fukamashi et al. (USPN 5,706,259; "Fukamashi") for the reasons provided on pages 5-6 of the above referenced Office Action. Applicants respectfully traverse.

Each of claims 9 and 16 depend from claims 7 and 15 respectively. As indicated above, each of claims 7 and 15 are considered to be patentable over the combination of Onagi and Nakayama. Thus, and at least because of their dependency from a base claim that is considered to be allowable, each of claims 9 and 16 are considered to be allowable.

As to the tertiary reference, Fukamashi, this reference is being cited as basis for the features/ limitations set forth in claims 9 and 16. As such, Fukamashi does not overcome the shortcomings identified above for each of claims 7 and 15. Applicant also would note that Fukamashi like Onagi and Nakayama is directed to a magneto-optical recording medium; and thus Fukamashi also does not disclose, teach or suggest methods for recording magnetic signals in a magnetic recording medium as those terms are used in the subject application. More particularly, Fukamashi does not anywhere describe, disclose, teach, suggest nor provide the technical content that one skilled in that art would assert corresponded to characteristics of the present invention, more specifically that the edge of the recordable region is located in a position in which the magnetic field intensity is lowered at the greatest rate.

It is respectfully submitted that claims 9 and 16 are patentable over the cited reference(s) for the foregoing reasons.

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### CLAIMS 3, 11

Claims 3 and 11 stand rejected as being unpatentable over Onagi (USPN 5,757,736) in view of Nakayama et al. (USPN 5,666,332; "Nakayama") as applied to claims 1 and 7, respectively, and further in view of Ishida et al. (USPN 6,347,016; Ishida") for the reasons provided on page 6 of the above referenced Office Action. Applicants respectfully traverse.

Each of claims 3 and 11 depend from claims 1 and 7 respectively. As indicated above, each of claims 1 and 7 are considered to be patentable over the combination of Onagi and Nakayama. Thus, and at least because of their dependency from a base claim that is considered to be allowable, each of claims 3 and 11 are considered to be allowable.

As to the tertiary reference, Ishida, this reference is being cited as basis for the features/limitations set forth in claims 3 and 11. As such, Ishida does not overcome the shortcomings identified above for each of claims 1 and 7. Also, Ishida does not anywhere describe, disclose, teach, suggest nor provide the technical content that one skilled in the art would assert corresponded to characteristics of the present invention, more specifically that the edge of the recordable region is located in a position in which the magnetic field intensity is lowered at the greatest rate.

It is respectfully submitted that claims 3 and 11 are patentable over the cited reference(s) for the foregoing reasons.

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The following additional remarks shall apply to each of the above.

The Federal Circuit has indicated in connection with 35 U.S.C. §102 that in deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify *corresponding elements* disclosed in the allegedly anticipating reference (emphasis added, citations in support omitted). *Lindemann Maschinenfabrik GMBM v. American Hoist and Derrick Company et al.*, 730 F. 2d 1452, 221 USPQ 481,485 ( Fed. Cir. 1984). Notwithstanding that the instant rejection is under 35 U.S.C. §103, in the present case the Examiner has not shown that features and methodology of the cited prior art correspond, as that term is used above by the Federal Circuit, in any fashion to the allegedly equivalent features or method steps in its entire claimed form as set forth in any of the independent claims of the present invention.

As provided in MPEP 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F. 2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F. 2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As provided above, the references cited, alone or in combination, include no such teaching, suggestion or motivation.

Furthermore, and as provided in MPEP 2143.02, a prior art reference can be combined or modified to reject claims as obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 19866). Additionally, it also has

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been held that if the proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. Further, and as provided in MPEP-2143, the teaching or suggestion to make the claimed combination and the reasonable suggestion of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As can be seen from the foregoing discussion regarding the disclosures of the cited references, there is no reasonable expectation of success provided in the reference(s). Also, it is clear from the foregoing discussion that the modification suggested by the Examiner would change the principle of operation of the device/apparatus that is disclosed in Onagi.

As the Federal circuit has stated, “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.2d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995).

Therefore, the cited references alone or in the combinations set forth in the rejections are utterly different in their objects and accordingly in their arrangements from the methods and apparatus claimed by Applicants. Stated another way, the methods and apparatus of the present invention and disclosures of the cited references are totally different from each other in terms of the technical concepts thereof. Thus, not only the combination of Onagi and Nakayama, but also

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any of the other combinations of references described in the above referenced Office Action will not yield, disclose, suggest, nor teach the arrangement of the present invention, in particular the arrangements as set forth in any of the independent claims, claims 1, 7, 15, 17 and 18. Moreover, the unique and non-obvious feature(s) of the present invention cannot be attained, disclosed, taught or suggested by combining the cited references in any of the ways described in the Office Action. Further none of the references anywhere disclose, teach or suggest that the significant effect(s) described above for the present invention are achievable.

As provided by the Federal circuit, a 35 U.S.C. 103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in a reference, is not proper and the *prima facie* case of obviousness cannot be properly made. In short there would be no technological motivation for engaging in the modification or change. To the contrary, there would be a disincentive. *In re Gordon*, 733 F. 2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case it is clear that if the magneto-optical recording apparatuses disclosed in Onagi or Nakayama were modified so as to be capable of recording information in a magnetic recording medium and to read that recorded information out magnetically, it would destroy the intent, purpose or function of the device as taught by either Onagi or Nakayama.

It is respectfully submitted that for the foregoing reasons, claims 1-18 are patentable over the cited reference(s) and satisfy the requirements of 35 U.S.C. §103. As such, these claims are allowable.

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It is respectfully submitted that the subject application is in a condition for allowance.

Early and favorable action is requested.

Applicants believe that additional fees are not required for consideration of the within Response. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit Account No. 04-1105.

Respectfully submitted,  
Edwards & Angell, LLP

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